

PATENT
674523-2011

#7

Election
4/18/03**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s) : Kingsman, et al.
Serial No. : 10/001,220
For : IMPROVED RETROVIRAL PRODUCTION
Filed : November 15, 2001
Examiner : S. Brown
Art Unit : 1648

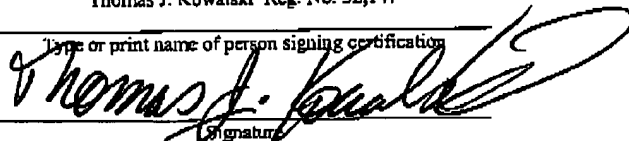
745 Fifth Avenue, New York, NY 10151

FACSIMILE

I hereby certify that this paper is being facsimile transmitted
to the Patent and Trademark Office on the date shown below.

Thomas J. Kowalski Reg. No. 32,147

Type or print name of person signing certification



9 Apr 03

Date of Signature

RESPONSE TO OFFICE ACTION

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This is in response to the March 17, 2003 Office Action, which set a one month period
for response. The Office Action required restriction from among:

- Group I: Claims 1-10, 13 and 16-18, drawn to a method of enhancing production of an
infectious retrovirus, classified in class 435, subclass 5;
- Group II: Claims 11-12, drawn to a composition comprising an infectious retrovirus,
classified in class 424, subclass 208.1;
- Group III: Claims 14-15, drawn to a nucleotide sequence, classified in class 536,
subclass 23.1.

Group I is elected, with traverse, for further prosecution in this application. Applicants
reserve the right to file divisional applications to non-elected subject matter. Reconsideration
and withdrawal of the restriction requirement are respectfully requested in view of the remarks
herewith.

PATENT
674523-2011

As a traverse, it is noted that the MPEP lists two criteria for a proper restriction requirement. First, the inventions must be independent or distinct. MPEP § 803. Second, searching the additional inventions must constitute an undue burden on the examiner if restriction is not required. *Id.* The MPEP directs the examiner to search and examine an entire application "[i]f the search and examination of an entire application can be made without serious burden, ...even though it includes claims to distinct or independent inventions." *Id.*

It is respectfully submitted that any search for the methods for enhancing the production of an infectious retrovirus of the Group I claims will certainly encompass references for the composition comprising the infectious retrovirus of the Group II claims. The two groups are inextricably linked in that the Group I claims are drawn to a process for making the product of the Group II claims. The enhanced retroviral production system and resulting producer cells (Group I) would require the same consideration as the infectious retrovirus produced therefrom. Therefore, it is respectfully submitted that it would not place an unnecessary burden on the Examiner to search and examine both groups together, as a search for the Group I methods would necessarily include the Group II retrovirus.

The result of the present restriction requirement is inefficiency and unnecessary expenditures by both the Applicants and the PTO and extreme prejudice to Applicants (particularly in view of GATT, a shortened patent term may result in any divisional applications filed). Restriction has not been shown to be proper, especially since the requisite showing of serious burden has not been made in the Office Action and there are relationships, as admitted in the Office Action, between claims 1-10, 13 and 16-18 of Group I and claims 11 and 12 of Group II. These factors mitigate against restriction.

Reconsideration and withdrawal of the requirement for restriction, or at least reformulation of the requirement such that claims 11 and 12 are included in Group I, and favorable consideration of claims 1-13 and 16-18 on the merits are requested.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP

By: 

Thomas J. Kowalski
Reg. No. 32,147
(212) 588-0800